

Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Applicants : Paul J. Coleman et al. .
Serial No. : 10/567,249 Case No.: 21484P . Art Unit:
Filed : February 06, 2006 . 1624
For : MITOTIC KINESIN INHIBITORS . Examiner:
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REQUEST FOR RECONSIDERATION
OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. § 1.705(d)

Sir:

With reference to the Issue Notification mailed October 02, 2009 the Applicants respectfully request reconsideration of the Patent Term Adjustment for this application under 35 U.S.C. § 154(b).

This Request for Reconsideration of Patent Term Adjustment is being submitted by EFS on March 04, 2010, within 2 months of the issuance of this application as US Patent 7,666,862 on February 23, 2010, and is accompanied by the fee set forth in 37 C.F.R. § 1.705(b)(1) and § 1.18(e). Any additional fees associated with this Request may be charged to Merck Deposit Account No. 13-2755.

REMARKS

The Issue Notification mailed November 11, 2009, indicated that the total patent term adjustment calculated by the Patent Office for this application is 715 days. Applicants hereby respectfully request reconsideration of the patent term adjustment for this application. Specifically, Applicants believe that the total patent term adjustment should be 1045 days.

In support of this request, Applicants submit the following statement of facts pursuant to 37 C.F.R. § 1.705(b).

REVIEW OF PATENT TERM ADJUSTMENT CALCULATION

"A Delay"

The Office indicated that the patent term adjustment under 37 C.F.R. § 1.702(a) as calculated under 37 C.F.R. § 1.703(a) is 715 days. The beginning of the relevant period for purposes of calculating "A Delay" is the date on which the application fulfilled the requirements of 35 USC 371. This US national stage application fulfilled the requirements of 35 USC 371 on February 15, 2006.

A first PTO action was due on or before April 15, 2007 (the date that is fourteen months after the date that the US national stage application fulfilled the requirements of 35 USC 371 on February 15, 2006). The PTO mailed the first Office Action on March 30, 2009, thereby according a PTO Delay of 715 days.

Applicants agree with the determination by the Office that the patent term adjustment under 37 C.F.R. § 1.702(a) as calculated under 37 C.F.R. § 1.703(a) is 715 days.

"B Delay"

Applicants respectfully submit that the patent term adjustment under 37 C.F.R. § 1.702(b) as calculated under 37 C.F.R. § 1.703(b) is 373 days.

The beginning of the relevant period for purposes of calculating "B Delay" is the date on which the application was commenced under the provisions of 35 USC 371(b). The US national stage for this application was commenced on February 15, 2006.

US Patent 7,666,862 granted from the subject application on February 23, 2010. The US national stage for this application was commenced on February 15, 2006. Accordingly, the application should have issued within three years later, on February 15, 2009. However, the actual issue date was February 23, 2010. The difference between the date when the application should have issued to patent on February 15, 2009, and the date that the application actually issued to patent on February 23, 2010, is 373 days.

Overlap of "A Delay" and "B Delay"

As detailed above, "A Delay" accumulated during the following period:
April 15, 2007 to March 30, 2009

As detailed above, "B Delay" accumulated during the following period:
February 15, 2009 to February 23, 2010

The "A Delay" and the "B Delay" overlap (i.e. occur on the same calendar day) for a total of 43 days.

The adjustment sought under 37 C.F.R. § 1.703(f) is the sum of the periods under § 1.702(a) (715 days) and § 1.702(b) (373 days), less the additional delays attributable to Applicant (0 days), less the days that such periods overlap (43 days). Accordingly, Applicants respectfully request an adjustment of patent term under § 1.703(f) to indicate a total Patent Term Adjustment of 1045 days.

In support of Applicants' request for the adjustment under § 1.703(f) to include the sum of the periods under 1.702(a) and § 1.702(b), rather than the greater of these two periods, Applicants rely on the decision of the Federal Circuit in Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan 7, 2010). In that decision, the Court affirmed the reasoning by the District Court that construed the meaning of the statutory provision regarding the limitations on extensions granted for delays under 35 U.S.C. § 154(b)(1)(A-C):

- (A) In general. -- To the extent that periods of delay attributable to grounds specified in paragraph (1) overlap, the period of any adjustment granted under this subsection shall not exceed the actual number of days the issuance of the patent was delayed.

35 U.S.C. § 154(b)(2)(A). The court stated that “[t]he operative question under 35 U.S.C. § 154(b)(2)(A) is whether periods of delay attributable to grounds specified in paragraph (1) overlap.” See Memorandum Opinion at p. 8. (internal quotations omitted). In the opinion of the district court, “[t]he only way that periods of time can “overlap” is if they occur on the same day.” Id. The court thus rejected the Patent Office’s view that any administrative delay under 35 U.S.C. § 154(b)(1)(A) (“A delays”) overlaps with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B) (“B delay”). In the district court’s view, the only A delays which overlap with the B delay are those which occur after the B period begins, which is when the Patent Office has failed to issue a patent within three years of an application’s filing date, and not before. See Memorandum Opinion at p. 5-6, 9.

Applying the rule in Wyeth v. Kappos to the present facts, the period for A delays ends on February 15, 2009, which is three years from the filing date of this application, February 15, 2006. The period for B delay begins on February 15, 2009, and ends on the date of issuance of the patent on February 23, 2010, a period of 373 days inclusive. Accordingly, the total patent term adjustment should be calculated from the sum of the non-overlapping A and B periods 715 + 373 - 43 days, less the delays due to applicant during the B period, 0 days, giving a total of 1045 days

Terminal Disclaimer

Applicants note that the above-identified application is not subject to a terminal disclaimer.

Applicant Delay

There was no Applicant delay.

Considering the decision of the Federal Circuit in Wyeth v. Kappos, No. 2009-1120 (Fed. Cir., Jan 7, 2010), Applicants respectfully request that the patent term adjustment determination be reconsidered.

In summary, Applicants respectfully requests an adjustment of patent term under 37 C.F.R § 1.703(f) to indicate a total PTA of 1045 days. Favorable consideration of this request is earnestly solicited.

Respectfully submitted,

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